

because of minor informalities, as discussed in paragraph 2 of the Office Action. The examiner also rejected claims 1-7, 12-19, and 24 under 35 U.S.C. § 102(e) as being anticipated by Tadokoro, et al. (U.S. Patent No. 6,166,877 (Tadokoro)).

The examiner did not make any substantive rejections with respect to claims 8-11, and 20-23. Therefore, with the exception of the provisional double-patenting rejection with respect to these claims, the applicants believe that the examiner will allow these claims.

Applicant believes that the pending claims are not anticipated by, nor obvious over the cited references and respectfully traverses the examiner's rejections for the reasons that will be set forth below.

Re the Drawings:

Formal drawings are submitted herewith. No new matter is thereby introduced.

Re the Claims:

Claim 2 is cancelled.

Claim 1 has been amended to include the limitation of original claim 2, and that the guide member and gear rack are integral with one another. Specifically, amended claim 1 recites "a first elongate guide member integral with said first elongate gear rack . . ." and "a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member".

Claim 3, which originally depended from claim 2, has been

amended to depend from claim 1.

Claim 8 has been amended to independent form. Claim 8 formerly depended from original claim 1. Therefore, each of the limitations of original independent claim 1 has been incorporated into amended claim 8.

Claim 13 has been amended to include the limitation that the first elongate guide member is "integral with" the first elongate gear rack.

Claim 15 has been amended to correct a typographical error.

Claim 24 has been amended to include the limitation that the guide means is "integral with" the elongate gear rack.

Legal Standard For Rejecting Claims Under 35 U.S.C. § 102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (Fed. Cir. 1991). Every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (finding that the jury had been erroneously instructed

that anticipation may be shown by equivalents, a legal theory that is pertinent to obviousness under Section 103, not to anticipation under Section 102). "The identical invention must be shown in as complete detail as is contained in the patent claim." MPEP, Volume 2, §2131 (7<sup>th</sup> Ed. 1998) (citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990).

"It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office." *Ex parte Skinner*, 2 USPQ2d 1788, 1788-1789 (Bd. Pat. Int. 1986) (holding that examiner failed to establish *prima facie* case of anticipation). The examiner has "the burden of proof . . . to produce the factual basis for its rejection of an application under sections 102 or 103." *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967)). Only if that burden is met, does the burden of going forward shift to the applicant.

#### Discussion of the Reference

**Tadokoro, et al., U.S. Patent No. 6,166,877 (Tadokoro):** The Tadokoro reference discloses a cassette auto changer system including, among other things, a selection member for selecting between a plurality of cassettes. In particular, with respect to the embodiment shown in FIG. 19, FIG. 20, and FIG. 21, Tadokoro discloses a cassette transfer mechanism 2 with upper and lower horizontally arranged rack members 32, 32 disposed so as to

engage the upper and lower guide rails 8, 8 disposed on each of the consoles A-D. A vertical pillar 30 is supported between the upper and lower rack members 32 so as to be movable in a horizontal plane. Upper and lower end portions 30a, 30b attached to each end of the pillar 30 include a plurality of guide rollers 33 for pressingly engaging the guide rails 8 at three sides thereof to provide stable support and rolling movement for the cassette transport mechanism 2. A pulley 35 mounted on the drive shaft of the motor 34 engages a timing belt which further engages a drive pulley 37 on rotatable shaft 38. Drive gears 29, 29 are engaged with adjacent reduction gears 40, 40 at each side thereof. Smaller pinion gears are coaxially disposed at upper sides of the upper reduction gears 40, 40 and lower sides of the lower reduction gears 40, 40 to engage horizontal rack gear teeth formed on the upper and lower rack members 32, 32.

#### Argument

Claims 1-7, 12-19, and 24 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,166,877 to Tadokoro, et al. (hereinafter, "Tadokoro") for the reasons set forth in the Office Action. However, none of the prior art references disclose or make obvious a translation apparatus that meets each of the limitations of each of the currently pending claims. Consequently, each of the currently pending claims is allowable over the prior art of record.

Claim 1 has been amended to include the limitations of original claim 2 and that the guide member be integral with the gear rack. That is, claim 1 now includes the limitations of "a first elongate guide member integral with said first elongate

gear rack and extending along the displacement path substantially between the first and second ends of said first elongate gear rack" and "a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member". As discussed in more detail below, these limitations are not disclosed in, nor obvious in view of, Tadokoro.

The examiner asserts that the limitations of a guide member and bearing, as presented in original claim 2, are anticipated by Tadokoro. Specifically, with reference to FIG. 20 and FIG. 21, Tadokoro shows rack members 32 engaging upper and lower guide rails 8, and a plurality of guide rollers 33 pressingly engaging the guide rails 8 (see specification Col. 14, lines 9-20). [However, Tadokoro does not disclose an integral guide member and gear rack. Instead, the guide rails 8 disclosed in Tadokoro are separately connected to the rack members 32. This design increases the likelihood that the gears 41 and the rack members 32 are misaligned during assembly. Such misalignment may result in binding, slipping, and/or uneven wear of the gears 41 and the rack members 32.]

The applicants' invention, on the other hand, requires that the guide member (e.g., portion 50) and the gear rack (e.g., 20) be integral with one another, as shown in FIG. 1, FIG. 2, and FIG. 3. For example, "in one preferred embodiment, both the lower and upper gear racks 20 and 22 are fabricated from sheet metal with the respective guide member portions 50 and 52 thereof comprising up-turned and down-turned edge portions, respectively" (see specification page 11, lines 31-35). As such, the integral guide member and gear rack of the applicants' invention eliminates an assembly step that would otherwise require precision to ensure that the guide rail is assembled to the gear

rack within required tolerances to avoid misalignment of one with the other.

For the above reasons, the applicants believe that independent claim 1, as amended, is not anticipated by, nor obvious in view of, Tadokoro. The examiner also asserts § 102(e) rejections against dependent claims 2-7, and 12. Dependent claim 2 has been cancelled. In addition, as independent claim 1 is not anticipated by, nor obvious in view of, Tadokoro, it follows that the remaining dependent claims 3-7, and 12 are also not anticipated by, nor obvious in view of, Tadokoro. As such, although the remaining dependent claims 3-7, and 12 are also believed to be allowable on their own grounds, these claims will not be discussed in further detail herein.

Claim 13 has been amended to include the limitation of "a first elongate guide member integral with said first elongate gear rack". Again, the examiner asserts that the guide member and bearing are anticipated by Tadokoro. However, as explained above with respect to claim 1, the integral guide member and gear rack of the applicants' invention are not disclosed by, nor made obvious by, the cited prior art.

For the above reasons, the applicants believe that independent claim 13 is patentable over Tadokoro. The examiner also asserts § 102(e) rejections against dependent claims 14-19. As independent claim 13 is not anticipated by, nor obvious in view of, Tadokoro, it follows that the dependent claims 14-19 are also not anticipated by, nor obvious in view of, Tadokoro. As such, although dependent claims 14-19 are also believed to be allowable on their own grounds, these claims will not be discussed in further detail herein.

Claim 24 has been amended to include the limitation of

"guide means integral with said elongate gear rack". As explained above with respect to claims 1 and 13, the integral guide means of the applicants' invention is not disclosed by, nor made obvious by, the cited prior art.

**Provisional Rejection of Claims 1-24 under Obviousness-Type Double Patenting:**

The examiner provisionally rejected claims 1-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of commonly owned pending U.S. Patent Application Serial No. 09/371,708. The applicants will submit a terminal disclaimer upon the examiner indicating that the claims are otherwise allowable.



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CONCLUSION

Applicant believes that all of the claims currently pending in this patent application, as amended and as discussed above, are allowable and that all other problems raised by the examiner have been rectified. Therefore, applicant respectfully requests the examiner to reconsider his rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicant's attorney at the telephone number below.

Respectfully Submitted,

DAHL & OSTERLOTH, L.L.P.

By: 

Bruce E. Dahl

Reg. No. 33,670

555 17<sup>th</sup> Street, Suite 3405  
Denver, Colorado 80202  
Tel.: (303) 291-3200  
FAX: (303) 291-3201

Date: 8-2-01



APPENDIX

CHANGES MADE TO CLAIMS

Claim 2 has been cancelled.

Claim 1 has been amended as follows:

1. (Amended) Translation apparatus for moving a cartridge access device along a displacement path, comprising:

a first elongate gear rack aligned along the displacement path, said first elongate gear rack having a first end and a second end;

a first elongate guide member integral with said first elongate gear rack and extending along the displacement path substantially between the first and second ends of said first elongate gear rack;

a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member;

a second elongate gear rack aligned along the displacement path and positioned in spaced-apart relation to said first elongate gear rack, said second elongate gear rack having a first end and a second end;

a first drive pinion mounted to the cartridge access device, said first drive pinion engaging said first elongate gear rack;

a second drive pinion mounted to the cartridge access device, said second drive pinion engaging said second

elongate gear rack; and

pinion drive apparatus operatively associated with said first and second drive pinions, said pinion drive apparatus rotating said first and second drive pinions to move the cartridge access device between the first and second ends of said first and second elongate gear racks.

Claim 3 has been amended as follows:

3. (Amended) The translation apparatus of claim [2] 1, wherein said first elongate guide member comprises first and second opposed bearing surfaces and wherein said first bearing mounted to the cartridge access device slidably engages the first and second opposed bearing surfaces of said first elongate guide member.

Claim 8 has been amended as follows:

8. (Amended) [The translation apparatus of claim 1, further comprising:] Translation apparatus for moving a cartridge access device along a displacement path, comprising:

a first elongate gear rack aligned along the displacement path, said first elongate gear rack having a first end and a second end;

a second elongate gear rack aligned along the displacement path and positioned in spaced-apart relation to said first elongate gear rack, said second elongate gear rack having a first end and a second end;

a third elongate gear rack positioned in generally

parallel, spaced-apart relation to said first elongate gear rack; [and]

a fourth elongate gear rack positioned in generally parallel, spaced-apart relation to said second elongate gear rack so that said first, second, third, and fourth elongate gear racks define a generally rectangular, parallelopiped configuration with said first and third elongate gear racks defining a bottom side of the generally rectangular, parallelopiped configuration and said second and fourth elongate gear racks defining a top side of the generally rectangular, parallelopiped configuration;[.]

a first drive pinion mounted to the cartridge access device, said first drive pinion engaging said first elongate gear rack;

a second drive pinion mounted to the cartridge access device, said second drive pinion engaging said second elongate gear rack; and

pinion drive apparatus operatively associated with said first and second drive pinions, said pinion drive apparatus rotating said first and second drive pinions to move the cartridge access device between the first and second ends of said first and second elongate gear racks.

Claim 13 has been amended as follows:

13. (Amended) Translation apparatus for moving a cartridge access device along a displacement path, comprising:

a first elongate gear rack aligned along said displacement path, said first elongate gear rack having a first end and a second end;

a first elongate guide member [mounted to] integral with said first elongate gear rack so that said first elongate guide member extends along the displacement path;

a second elongate guide member extending along the displacement path and positioned in spaced-apart relation to said first elongate guide member;

a first drive pinion mounted to the cartridge access device, said first drive pinion engaging said first elongate gear rack;

a first bearing mounted to the cartridge access device, said first bearing engaging said first elongate guide member;

a second bearing mounted to the cartridge access device, said second bearing engaging said second elongate guide member; and

pinion drive apparatus operatively associated with said first drive pinion, said pinion drive apparatus rotating said first drive pinion to move the cartridge access device along the displacement path.

Claim 15 has been amended as follows:

15. (Amended) The translation apparatus of claim 14, wherein said second elongate guide member comprises an integral portion of [Siad] said second elongate gear rack.

Claim 24 has been amended as follows:

24. (Amended) Translation apparatus for moving a cartridge access device along a displacement path, comprising:

an elongate gear rack aligned along the displacement path;

guide means [mounted to] integral with said elongate gear rack for guiding the cartridge access device along the displacement path;

a drive pinion mounted to the cartridge access device, said drive pinion engaging said elongate gear rack; and pinion drive means operatively associated with said drive pinion for rotating said first drive pinion to move the cartridge access device along the displacement path.